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JOSEPH M. SAUER			EXAMINER	
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CLEVELAND, OH 44114			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/782,691

Applicant(s)

HASSAN ET AL.

Examiner

Kuen S. Lu

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE filed 4/11/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

2. Applicant's amendment filed April 11, 2007 canceling claims 1-18 and adding new 19-32 is acknowledged.

3. As to Applicant's Arguments/Remarks filed April 11, 2007, please see Examiner's response in "***Response to Arguments***", following this Office Action for non-Final Rejection (hereafter "the Action"), shown next.

### ***Specification***

4. Claims 28-29 are objected to because of the following informalities:

As per claim 28, the term "input filed" and "data times" seems to be typographical errors of "input field" and "data items", respectively.

As per claim 29, the claim depends upon claim 1 which has been canceled. For claim examination, Examiner interprets claim 29 a mobile device of claim 28.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

**5.1.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5.2.** Claims 19-21 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Mendez (U.S. Patent Application 2003/0097358).

As per claim 19, Mendez teaches "In a system having a server that is operable to communicate with a mobile device over a wireless network, a method for searching a server application databases associated with the server" (See Fig. 1 and [0028] where a PDA is communicated to remote sever via network for searching remote database at the server), comprising:

"receiving a search request on the mobile device that includes one or more search parameters" (See Figs. 1, element 160, 6-7 and [0028] where user inputs search type, search terms and target database for executing the search);

"searching a local application database on the mobile device to identify one or more data items stored in the local application database matching the search parameters" (See [0029] and [0032]-[0033] where search on local database at PDA is conducted and

search terms matching data elements are identified);

“displaying on the mobile device a list of the one or more data items identified from the local application database” (See Fig. 4, element 400 and [0031] where matched and identified data elements of search result are displayed);

“displaying an input field on the mobile device to enable a user to instruct the mobile device to execute a remote search operation” (See Figs. 4, 6-8 and [0028] and [0037] where a form field Remote Directory Information for selecting remote database is displayed and available for user to instruct PDA to conduct remote database search);

“if the user instructs the mobile device to execute the remote search operation, then: transmitting a remote search request to the server that includes the search parameters, wherein the server uses the search parameters to identify one or more data items stored in the server application database matching the search parameters” (See Fig. 7 and [0030]-[0031] where searching remote database is determined, remote database search is conducted based on search terms received by the remote system, data elements matching search terms are identified and displayed on the PDA);

“receiving an identification of the one or more data items identified from the server application database” (See Fig. 7 and [0030]-[0031] where searching remote database is determined, remote database search is conducted based on search terms received by the remote system, data elements matching search terms are identified and displayed on the PDA); and

“displaying on the mobile device a list of the one or more data items identified from the server application database” (See Fig. 7 and [0030]-[0031] where searching remote

database is determined, remote database search is conducted based on search terms received by the remote system, data elements matching search terms are identified and displayed on the PDA).

As per claim 28, Mendez teaches "In a system having a server that is operable to communicate with a mobile device over a wireless network, the server including a server application database for storing a copy of data items that are transmitted to the mobile device and a server-based remote search module operable to retrieve one or more search parameters from the mobile device and use the search parameters to identify one or more data items stored in the server application database that match the search parameters" (See Fig. 1 and [0028] where a PDA is communicated to remote sever via network for searching remote database at the server, in [0019]-[0021] where PDA having local database and memory installed is communicated to, via network, a remote server equipped with a remote database for synchronizing local data with remote data, and further in Figs. 6-7 and [0028] where user inputs search type, search terms and target database for executing the search), the mobile device comprising: "a memory subsystem that includes a local application database for storing data items for one or more software applications" (See [0029] and [0032]-[0033] where search on local database at PDA is conducted and search terms matching data elements are identified); "a communication subsystem operable to transmit and receive data over the wireless network" (See Fig. 1, element 140 and [0028]-[0031] where network communicates

PDA and remote server system for transferring search parameters and returning search result);

“a display” (See Fig. 2, element 240 is a display on example computer);

“a local search module that causes the mobile device to identify one or more data items stored in the local application database that match one or more parameters,

a list of the one or more data ~~times~~ items being displayed on the display along with an input ~~field~~ field to enable a user to instruct the mobile device to execute a remote search operation” (See Figs. 1, element 160, 6-7, [0028]-[0029] and [0032]-[0033] where user inputs search type, search terms and target database for executing the search and search on local database at PDA is conducted and search terms matching data elements are identified, and at Figs. 4, 6-8 and [0028] and [0037] where a form field Remote Directory Information for selecting remote database is displayed and available for user to instruct PDA to conduct remote database search);

“a remote search module that causes the mobile device to transmit a remote search request to the server in response to the user instructions to execute the remote search operation,

the remote search request including the one or more parameters, which are used by the server to identify one or more data items stored in the server application database matching the one or more parameters,

wherein the mobile device receives the one or more data items identified from the server application database and displays a list of the one or more data items from the server application database on the display” (See Fig. 7 and [0030]-[0031] where

searching remote database is determined, remote database search is conducted based on search terms received by the remote system, data elements matching search terms are identified and displayed on the PDA).

As per claim 20, Mendez teaches "The method of claim 19, further comprising: "displaying a second input field on the mobile device to enable the user to instruct the mobile device to retrieve a selected data item from the server application database" (See Fig. 8 and [0038] where search terms and additional options are available for user to search and retrieve data elements from remote server database); and "if the user instructs the mobile device to retrieve the selected data item from the server application database, then transmitting a data item request to the server and receiving a copy of the selected data item from the server" (See Fig. 8 and [0038] where search terms and additional options are available for user to search and retrieve data elements from remote server database).

As per claim 21, Mendez teaches "The method of claim 19, further comprising: displaying the list of the one or more data items identified from the server along with the list of the one or more data items identified from the local application database, the displayed list of data items identified from the server having one or more characteristics that distinguish them from the displayed list of data items identified from the local application database" (See Fig. 10 where local and remote database data records are identified differently).



***Claim Rejections - 35 USC § 103***

**6.1.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**6.2.** Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez (U.S. Patent Application 2003/0097358).

As per claim 26, Mendez teaches "In a system having a server that is operable to communicate with a mobile device over a wireless network, the server including a server application database for storing copies of data items that are transmitted to the mobile device and the mobile device including a memory subsystem for storing data items on the mobile device" (See Fig. 1 and [0019]-[0021] where PDA having local database and memory installed is communicated to, via network, a remote server equipped with a remote database for synchronizing local data with remote data).

Mendez does not explicitly teach "determining that additional memory space is needed on the mobile device".

However, Mendez teaches deciding if data elements of search result is voluminous and refining data request for returning a pre-specified number of data elements which can be simultaneously displayed (See Fig. 4, element 400 and [0032]).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to substitute the teaching of determining if the number of data elements is voluminous with determining the size of data elements and if additional memory space is needed to support displaying the data elements because determining memory size is more accurate than number of records for display data, and the substitute teaching would have enabled local and remote systems to flexibly and dynamically decide the number of data elements allowed to display in each search without being limited to a pre-specified number and would have further improved data transfer due to better match between network band and PDA memory size (See [0025]).

Mendez further teaches the following:

"communicating with the server over the wireless network to determine if a copy of one or more data are stored in the server application database" (See Fig. 7 and [0030]-[0031] where searching remote database is determined, remote database search is conducted to determine if data elements matching search terms available at remote database and the data elements matching search terms are identified); and  
"if copies of the one or more data items are stored in the server application database, then deleting the one or more data items from the memory subsystem in the mobile device to create additional memory space" (See [0025] where PDA may contain limited

memory for storing data).

As per claim 27, Mendez teaches "The method of claim 27, further comprising: deleting all data items from the mobile device that have copies stored in the server application database before deleting any data items from the mobile device that do not have copies stored in the server application database" (See [0020] and [0041] where features are available for deleting data elements from local or remote database, or both and remote and local databases are synchronized).

**6.3.** Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez (U.S. Patent Application 2003/0097358), as applied to claim 19 above, and further in view of Roberts et al. (U.S. Patent Application 2003/0097358, hereafter "Roberts").

As per claim 22, Mendez does not explicitly teach "the one or more distinguishing characteristics include a font color", although Mendez teaches that the display is a GUI implementation at Fig. 7 and [0037].

However, Roberts teaches PDA display equipping with features for displaying time and GUI features such as fonts and colors (See [0013]).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Roberts with Mendez reference because the combined teaching of the references would have allowed

Mendez's system to better utilized the GUI inherent features to distinctly display data element for helping user to comprehend search result better.

As per claim 23, Roberts teaches "the one or more distinguishing characteristics include italicized font" (See [0013] where PDA display is equipped with GUI features of fonts and colors for display).

As per claim 24, Roberts teaches "the one or more distinguishing characteristics include non-italicized font" (See [0013] where PDA display is equipped with GUI features of fonts and colors for display).

As per claim 25, Roberts teaches "the one or more distinguishing characteristics include a font type" (See [0013] where PDA display is equipped with GUI features of fonts and colors for display).

**6.4.** Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez (U.S. Patent Application 2003/0097358), as applied to claim 28 above, and further in view of Wright, Jr. (U.S. Patent 5,857,201, hereafter "Wright").

As per claim 29, Mendez does not explicitly teach "The mobile device of claim [[1]] 28, wherein the one or more software applications include an electronic messaging application, the local application database includes an electronic mailbox for storing

electronic messages, and the server-based application database includes a corresponding electronic mailbox for storing a copy of the electronic messages received by the mobile device”, although Mendez teaches data elements including email addresses at Fig. 10.

However, Wright teaches PDA connecting email server at col. 2, lines 38-42.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Wright with Mendez reference because both references are directed to communication between PDA and remote system where each is equipped with database, and the combined teaching of the references would have enhance and improve PDA communication to remote system because email access would have been available for Mendez's PDA at the field. (See Wright: SUMMARY OF THE INVENTION).

As per claim 30, Wright teaches “The mobile device of claim 29, wherein the server includes an electronic mail server operable to send and receive electronic messages over one or more computer networks and store received electronic messages in the corresponding electronic mailbox” (See col. 2, lines 38-42 where PDA connects email server).

As per claim 31, Wright teaches “The mobile device of claim 30, wherein the server further includes an enterprise server for forwarding a copy of received electronic messages to the mobile device” (See col. 2, lines 38-42 where PDA connects email

server).

As per claim 32, the combined teaching of Wright and Mendez references further teaches "The mobile device of claim 30, wherein the electronic mailbox in the local application database is synchronized with the corresponding electronic mailbox in the server-based application database" (See Mendez: [0020] where local and remote databases are synchronized and Wright : col. 2, lines 38-42 where PDA connects email server).

### ***References***

#### **7.1. The prior art made of record**

- A. U.S. Patent No. 5,857,201
- G. U.S. Patent Application 2003/0097358
- H. U.S. Patent Application 2004/0037266

**7.2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

- A. U.S. Patent No. 5,857,201
- B. U.S. Patent Application 2003/0200282
- C. U.S. Patent Application 2003/0069874
- D. U.S. Patent No. 6,898,591
- E. U.S. Patent Application 2002/0116457
- F. U.S. Patent No. 5,701,461

### ***Response to Arguments***

8. As to Applicant's arguments, filed on November 9, 2006 and April 11, 2007, with respect to claims 19-32 has been fully considered but are moot in view of the new ground(s) of rejection.


***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S. Lu whose telephone number is (571) 272-4114. The examiner can normally be reached on Monday-Friday (8:00 am-5:00 pm). If attempts to reach the examiner by telephone pre unsuccessful, the examiner's Supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3900.

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Kuen S. Lu 

Patent Examiner, Art Unit 2167

June 10, 2007